

REMARKS

Reconsideration and allowance of the subject application are respectfully requested in light of the amendments above and the remarks that follow.¹ Claims 1-20 are pending. By this Amendment, Applicant has amended claims 1, 2, 6-8 and 17-19 to address formalities and improve clarity, but not for any reason with regard to the patentability of the recited subject matter.

Objection to the Specification

The Examiner apparently objects to the lack of section headings in Applicant's specification. (Office Action, p. 2.) Applicant appreciates the Examiner's quotation of 37 C.F.R. 1.77(b) included in M.P.E.P. § 608.01, which lists the preferred arrangement of the specification. However, this arrangement of the specification is only suggested - not required. In particular, with regard to the quoted passage, M.P.E.P. § 608.01 states, "The following order of arrangement of specification elements is preferable in framing the nonprovisional specification and each of the lettered items should appear in upper case, without underlining or bold type, as section headings" (emphasis added). Similarly, form paragraph 6.01 states "The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use" (emphasis added). Thus, there is no requirement that a specification included the section headings requested by the Examiner.

The Preliminary Amendment filed August 26, 2007, amended the specification to include section headings: "Background of the Invention" and "Description of the Invention." Applicant respectfully declines to further amend the specification.

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

Objection to the Claims

Applicant has amended the claims to provide antecedent basis for each of the claim terms. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the objection to the claims.

Rejection Under 35 U.S.C. § 112, First Paragraph

Applicant traverses the rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph. The first paragraph of 35 U.S.C. § 112 states, "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." Furthermore, Applicant advises, "The description need only describe in detail that which is new or not conventional." (See M.P.E.P. § 2163(II)(3)(a), *citing Hybritech v. Monoclonal Antibodies*, 802 F.2d at 1384, 231 USPQ at 94; *Fonar Corp. v. General Electric Co.*, 107 F.3d at 1549, 41 USPQ2d at 1805, emphasis added.)

As described in the "Background" section of Applicant's disclosure, one of ordinary skill in the art of secure electronic transactions would be familiar with, for instance, enciphering and/or signing algorithms using asymmetric keys (e.g., private key, public key), public key infrastructures (PKI), and the X509 format. (See, e.g., Specification, pp. 1:13-6:13.) Applicant respectfully submits one of ordinary skill in the art would have sufficient knowledge to make and use the claimed invention based on the "Detailed Description" section between page 6, line 14 and page 11, line 25 of Applicant's specification. Accordingly, claims 1-20 are enabled by the specification. Applicant, therefore, respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph.

The Office Action does not assert that one of ordinary skill in the art would not be enabled to make and use the claimed invention based on Applicant's specification. (Office Action, pp. 3-4.) The Examiner, therefore, has not established that the specification fails to satisfy the requirements of 35 U.S.C. § 112. Indeed, the Examiner's issue appears to be with the section headings (or lack thereof) in Applicant's specification and not the enablement of the disclosure. (Office Action, p. 3.) Neither 37 C.F.R. 1.77(b) nor M.P.E.P. § 608.01 requires section headings in a specification. Section 112 also makes no such requirement. Accordingly, the rejection under Section 112 is improper and should be withdrawn for this reason as well. Moreover, Applicant has found no authoritative basis to support the Examiner's argument with regard to the repetition of claim language in the specification. If the Examiner maintains the rejection under 35 U.S.C. § 112, first paragraph, Applicant respectfully requests that the Examiner cite some reference to support his interpretation of the specification.

As the Examiner is aware, the Applicant's specification includes headings delineating the "Background of the Invention" and the "Description of the Invention" sections. (*Id.* at p. 3.) Thus, there is no reasonable basis for interpreting the section "Description of the Invention," which follows the "Background" section to be background material. Furthermore, pursuant to 37 CFR § 1.75, Applicant's claims are identified by the section heading "Claims." As such, there is no reasonable basis for interpreting the section titled "Description of the Invention," which precedes the "Claims" section to be part of the claims.

The Examiner asserts, "Since the section that Applicant referred as Description of the Invention is an exact duplicate of the independent and dependent original claims listed from page 12 to 16, Examiner considers the disclosure of the invention as having only two parts: BACKGROUND OF THE INVENTION and CLAIMS." (*Id.* at p. 4) Applicant disagrees. The "Description of the Invention" section is not an "exact duplicate" of the claims, as asserted by the Examiner. (*Id.*) For example, page 10, line 26 to page 11, 25 describe exemplary

embodiments encompassed by the invention recited in the listing provided in the "Claims" section. Moreover, the repetition of claim language in the specification is no reason to interpret the "Description of the Invention" section to be claims or background; and the assertion does not support a rationale for lack of enablement. To the contrary, as noted above, enabling support for the claimed subject matter is provided in Applicant's specification between, at least, page 6, line 14 and page 11, line 25; and the Examiner has not asserted otherwise. As such, the rejection under Section 112 should be withdrawn.

Rejection of Claims 1-9 and 13-20 Under 35 U.S.C. § 102(a) & (e)

Applicant traverses the rejection of claims 1-9 and 13-20 under Section 102 as allegedly being anticipated by U.S. Patent Application Publication No. 2003/0115457 to *Wildish et al.* ("*Wildish*"). In order to properly anticipate Applicant's claim under Section 102, each and every element of the claim in issue must be found, either expressly described or under the principles of inherency, in a single prior art reference. (See M.P.E.P. § 2131 (8th Ed., rev. Aug. 2006).) Further, the identical invention must be shown in as complete detail as contained in the claim. (*Id.*, emphasis added.) *Wildish* fails in these regards.

Wildish discloses a certificate server 16 that includes, among other things, a key pair generator 27 and a data storage device 28. Data storage device 28 stores digital certificates issued by certificate server 16, including concatenated fields, ID1, ID2, ID3 a pseudonymic digital identifiers of a certified entity 14, 16, and a public key of the certified entity 14, 16.

The Examiner apparently asserts that *Wildish*'s concatenated fields correspond to Applicant's claimed "digital data identifying the proprietor of said public key and of an associated private key." In addition, it appears the Examiner asserts that key pair generator 27 and either data storage device or CPU 20 corresponds to Applicant's claimed "digital data ... identifying ... means of generating the private key" and "digital data ... identifying ... means of signing with the private key," respectively. Applicant respectfully disagrees.

Key pair generator 27, data storage device 28 and CPU 20 are devices - not data. *Wildish* says nothing with regard to including data identifying key pair generator 27, data storage device 28 and CPU 20 in the concatenated fields along with pseudonymic digital identifiers D1, ID2, ID3 and public key. Accordingly, *Wildish* does not disclose Applicant's claimed "digital data."

Because *Wildish* does not disclose the above-identified features of claim 1, *Wildish* cannot support a rejection of claim 1 under 35 U.S.C. § 102. Applicant, therefore, respectfully requests that the rejection of claim 1 under be withdrawn and the claim allowed.

Claim 8 although of different scope than claim 1, recites features similar to those in claim 1. Accordingly, claim 8 is allowable for the same reasons set forth above with regard to claim 1.

Claims 2-7, 9 and 13-20 depend from claims 1 and 8. Thus, claims 2-7, 9 and 13-20 are allowable at least to their corresponding dependence from allowable claims 1 and 8.

Rejection of Claims 10-12 Under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claim 10-12 under 35 U.S.C. § 103(a) as allegedly not being patentable over *Wildish* in view of U.S. Patent Application Publication No. 2004/0123107 to *Miyazaki et al.* ("*Miyazaki*"). Claims 10-12 depend from claim 8 and therefore include all the limitations of claim 8. Thus, *Wildish* fails to disclose or suggest the "digital data" of claims 10-12.

The Examiner relies on *Miyazaki* for its alleged disclosure of a message being accepted based on the probability of a key being used by a legitimate provider. (Office Action, p. 7.) *Miyazaki* does not disclose the "digital data" missing from *Wildish* and the Examiner does not assert that *Miyazaki* makes any such disclosure. Accordingly, *Wildish* and *Miyazaki*, taken individually or in combination, do not disclose or suggest the subject matter recited in claims 10-12. Applicant, therefore, respectfully requests that the rejection of claims 10-12 under Section 103 be withdrawn and the claims allowed.

Conclusion

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims.

If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

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